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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,797	12/14/2001	Steven M. Bessette	45112-200	1638

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Willem F. Gadiano, Esq.  
McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005

EXAMINER

AFREMOVA, VERA

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/014,797	<b>Applicant(s)</b> BESSETTE ET AL.	
	<b>Examiner</b> Vera Afremova	<b>Art Unit</b> 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,7-9,17,20 and 140-145 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,7-9,17,20 and 140-145 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .           |

Continuation of Attachment(s) 6). Other: Full official translations of the documents cited in the prior office action: DE 524,383 and references by Inazuka and by Watabe..

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### **DETAILED ACTION**

Claims 1, 7-9, 17, 20 as amended and new claims 140-145 {2/23/2004} are pending and under examination in the instant office action.

Claims 2-6, 10-16 18, 19 and 21-139 are canceled by applicants {2/23/2004}.

#### ***Claim Rejections - 35 USC § 112***

##### ***Indefinite***

Claims 8 and 9 as amended are rejected under 35 U.S.C. 112, *second paragraph*, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 9 recite the limitation "mineral oil" in a pesticidal composition. There is insufficient antecedent basis for this limitation in the claim 1.

##### ***New matter***

Claims 8 and 9 as amended are rejected under 35 U.S.C. 112, *first paragraph*, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Insertion of the limitation drawn to the use of the claimed ratio(s) between two components that are 1) active ingredient (wintergreen oil and/or rosemary oil) and 2) inert carrier (including mineral oil) has no support in the as-filed specification. The insertion of this limitation is a new concept because it neither has literal support in the as-filed specification by way of generic disclosure, nor are there specific examples of the newly limited genus that would

show possession of the concept of the use of the claimed ration between active ingredients and carrier. There is only generic disclosure of the ratio(s) 100:1 to 1:100 and 13:1 to 1:13 (page 6, last par.) that is drawn to the ratio(s) between 2 active ingredients but not the ratio(s) between active ingredient and carrier. This is not sufficient support for the new limitation as claimed. This is a matter of written description, not a question of what one of skill in the art would or would not have known. The material within the four corners of the as-filed specification must lead to the generic concept. If it does not, the material is new matter. Declarations and new references cannot demonstrate the possession of a concept after the fact. Thus, the insertion of the claimed ratio(s) between two components that are 1) active ingredient (wintergreen oil and/or rosemary oil) and 2) inert carrier (including mineral oil) is considered to be the insertion of new matter for the above reasons.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim rejection(s) under 35 U.S.C. 102(b) as being anticipated by Inazuka et al. (1982a) [IDS reference] or as being anticipated by Watanabe et al. have been withdrawn because the cited documents disclose the use of one active ingredient in the pesticidal composition.

Claims 1, 7-9, 17 and 20 as amended remain rejected under 35 U.S.C. 102(b) as being anticipated by DE 524 383.

Claims are directed to a pesticidal composition consisting essentially of a pesticidally acceptable carrier and a pesticidally effective amount of rosemary oil and wintergreen oil. Some

claims are further drawn to the use of carrier that comprises mineral oil. Some claims are directed to the use of equal amounts of rosemary and wintergreen oils in the composition.

DE 524 383 teaches a pesticidal composition for combating cockroaches, bugs, etc. (see English abstract) wherein the composition comprises rosemary oil, wintergreen oil and mineral oil (petroleum). The composition of the cited patent comprises equal amounts of rosemary oil (34 g) and wintergreen oil (34 g), for example: see col. 1, lines 27 and 30.

The cited patent is considered to anticipate the claimed invention as amended because it discloses an identical composition "consisting essentially" of 2 major components that are 1) carrier and 2) pesticidally effective amount of rosemary oil plus wintergreen oil. The fact that the cited patent DE 524 383 discloses the use of some additional components including some oils and/or carriers does not distinguish the referenced composition from the presently claimed composition because the claimed carrier is not limited to the use of a sole chemical(s) as a carrier by the virtue of open language "comprises" (claim 20) or "at least one" (claim 7). Furthermore, the presently claimed carrier(s) are not functionally inert but they are aromatic oils or oil derivatives and, thus, they are not pesticidally inert chemicals. Therefore, the additional oils and/or other components of the cited patent fall within the meaning of the presently claimed "pesticidally acceptable carrier" that includes oils or oil derivatives.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7-9, 17, 20 as amended and new claims 140-145 remain/are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 524 383 taken with the references by Inazuka et al.

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(1982a) [IDS reference], Watanabe et al., US 4,379,168 [IDS reference], US 6,004, 569 [IDS reference] and US 5,496,857.

Claims are directed to a pesticidal composition consisting essentially of a pesticidally acceptable carrier and a pesticidally effective amount of rosemary oil and wintergreen oil. Some claims are further drawn to the use of carrier that comprises mineral oil. Some claims are directed to the use of equal amounts of rosemary and wintergreen oils in the composition. Some claims are directed to the use of various carriers in the composition including mineral oil, benzyl alcohol, citronella, d-limonene, safflower oil, soybean oil and/or sesame oil.

The cited patent DE 524 383 is relied upon as explained above. The references by Inazuka et al. and by Watanabe et al. are relied upon as explained in the prior office action for the disclosure of pesticidal compositions comprising pesticidally effective amounts of either rosemary oil or wintergreen oil. The cited documents disclose the use of various carriers or diluents in pesticidal compositions including mineral oil (DE 524 383) or citronellal (see Watabe et al. at table II). But they are missing the particular disclosure related to the use of pesticidally acceptable or effective carriers such as benzyl alcohol, d-limonene, safflower oil, soybean oil and sesame oil.

However, the following documents are relied upon for the missing disclosure. For example: US 4,379,168 [IDS reference] teaches benzyl alcohol and citronellal as components of pesticidal mixtures (col. 3, lines 40-44 and line 60; col. 4, line 35). US 6,004, 569 [IDS reference] teaches the use of d-limonene as component of pesticidal mixtures. US 5,496,857 teaches safflower oil, soybean oil, sesame oil and also mineral oil as carriers and/or synergistic components in pesticidal mixtures (col. 2, lines 10-20, 43, 47, 55, 63 and 65).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add or to substitute at least one acceptable carrier(s) into the composition of the cited DE 524 383 with a reasonable expectation of success in combating pests including various insects because all components that are presently claimed have been known and used in pesticidal mixtures as acceptable carriers and/or synergistic diluents as demonstrated by the all cited references including cited documents Inazuka et al. (1982a) [IDS reference], Watanabe et al., US 4,379,168 [IDS reference], US 6,004, 569 [IDS reference] and US 5,496,857. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

Furthermore, it is noted that when an applicant contends that materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

Thus, the claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.



*Response to Arguments*

Applicants' arguments filed 2/23/2004 have been fully considered but they are not persuasive.

With respect to the cited DE 524383 applicants argue (response page 6, par. 2 and par. 4) that it does not teach and/or suggest a pesticidal composition having "combination of features" required by the claimed invention. However, the Federal Circuit has stated "By using the term 'consisting essentially of,' the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention." PPG Industries Inc. v. Guardian Industries Corp., 48 USPQ2d 1351, 1353 (Fed. Cir. 1998). The burden is on the applicant to show that ingredients in a reference which are not listed in a claim are excluded by "consisting essentially of" language meaning that they would effect the basic and novel characteristics of the claimed invention. Until a satisfactory showing is made, the term "consisting essentially of" is considered to be the equivalent of "comprising". See MPEP 2111.03.

Furthermore, applicants' arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out what are "features" that are argued and how the language of the claims, drawn to a "combination of features" that are presently argued, patentably distinguishes them from the references.

Applicants' arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which they think the claims present in view of the state of the art

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disclosed by the references cited. Further, they do not show how the amendments avoid such references.

No claims are allowed.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (571) 272-0914. The examiner can normally be reached from Monday to Friday from 9.30 am to 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926.

The fax phone number for the TC 1600 where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Vera Afremova

AU 1651

May 4, 2004

A handwritten signature in black ink, appearing to read 'V. Afremova', with a long horizontal flourish extending to the right.

VERA AFREMOVA

PATENT EXAMINER